REMARKS

The Examiner has rejected claims 29-31 under 35 U.S.C. § 103(a) as being obvious over Gold *et al.* (U.S. Pat. No. 5,270,163) in view of Bottaro *et al.*, further in view of Faletto *et al.*, further in view of Toothman *et al.* (U.S. Pat. No. 5,731,424), Jayasena *et al.* (U.S. Pat. No. 5,734,034) or Pagratis *et al.* (U.S. Pat. No. 5,837,834).

The Examiner bears the burden of establishing a prima facie case of obviousness. In determining obviousness, one must focus on Applicant's invention as a whole. *Symbol Technologies Inc. v. Opticon Inc.*, 19 USPQ2d 1241, 1246 (Fed. Cir. 1991). The primary inquiry is:

> whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success. . . . Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure.

In re Dow Chemical, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Additionally, prior art teachings cannot be combined to support an obviousness rejection absent some teaching, suggestion or incentive to support the combination. (*In re Geiger*, 2 USPQ2d 1276 (Fed. Cir. 1987)). It is not sufficient for establishing obviousness that the cited references contain the isolated elements recited in the claims; there must be a suggestion or motivation to combine the elements (*In re Regel* 188 USPQ 136 (CCPA 1975)).

The Examiner reasons that independent claim 29 of the instant application is drawn to a method for isolating nucleic acid ligands to c-met, comprising: a) preparing a candidate mixture of nucleic acids; b) contacting the candidate mixture of nucleic acids with c-met; c) partitioning the increased affinity nucleic acids from the remainder of the candidate mixture; and d) amplifying the increased affinity nucleic acids to yield a mixture of nucleic acids enriched for nucleic acids with relatively higher affinity and specificity for binding to c-met. The Examiner then reasons that Gold *et al.* teach a general method for identifying nucleic acid ligands of a target compound using the SELEX method. The Examiner acknowledges that Gold *et al.* do not teach the method for identifying nucleic acids specific to c-met. Regarding the Bottaro and Faletto references, the Examiner provides that Bottaro *et al.* teach that c-met is the HGF receptor and is activated in some tumor cell lines and Faletto *et al.* teach that compounds which bind to

HGF and inhibit its interaction with its receptor can prevent tumor metastasis. The Examiner then provides that Toothman *et al.,* Jayasena *et al.* and Pagratis *et al.* teach that the SELEX method can be used to obtain nucleic acid ligands to TGFβ, hKGF and elastase. From this the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the general method taught by Gold *et al.* to identify nucleic acid ligands to c-met. For the reasons discussed below Applicant respectfully traverses this rejection.

Statement under 35 U.S.C. § 103(c)

In the Office Action mailed in the referenced case on December 28, 2004, the Examiner noted that Gold *et al.* (U.S. Pat. No. 5,270,163) has both a common inventor and assignee with the instant application and as such it constitutes prior art only under 35 U.S.C. § 102(e). In response, the undersigned states that at the time the invention was made, the instant application (U.S. Application Serial No. 10/066,960) and Gold *et al.* U.S. Pat. No. 5,270,163, were both owned by Gilead Sciences, Inc. As a result the Gold *et al.* reference is disqualified from being used in a rejection under 35 U.S.C. § 103(a).

Regarding the remaining references Bottaro *et al.* and Faletto *et al.* merely teach that c-met is the HGF receptor and is activated in some tumor cell lines and that compounds which bind to HGF and inhibit its interaction with its receptor can prevent tumor metastasis. Neither of these references describes or suggests the development of nucleic ligands to c-met. While the '424, '034 and '834 patents teach that the SELEX method can be successfully used to obtain nucleic acid ligands to TGFβ, elastase and KGF, respectively, none of the references teach or suggest application of the SELEX method to c-met. Thus, the '424, '034 and '834 patents do not cure the deficiencies of the Bottaro *et al.* and Faletto *et al.* references.

As noted above, prior art teachings cannot be combined to support an obviousness rejection absent some teaching, suggestion or incentive to support the combination. It is not sufficient for establishing obviousness that the cited references contain the isolated elements recited in the claims; there must be a suggestion or motivation to combine the elements. The Examiner has pointed to the Gold patent to establish motivation to utilize the SELEX method to identify nucleic acid ligands to c-met. Since the Gold *et al.* reference is disqualified from being

used in a rejection under 35 U.S.C. § 103(a), Applicant maintains that the remainder of the references do not support an obviousness rejection of the subject claims.

Applicant believes that the pending claims are in condition for allowance. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117, if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,

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